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APPLICANT:	Edward Silver et al)	
)	
SERIAL NO.:	10/784,383)	ART UNIT:
)	2612
FILED:	February 23, 2004)	
)	EXAMINER:
FOR:	SYSTEMS AND METHODS FOR)	Blount
	IDENTIFICATION OF LOCATIONS))	

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REQUEST FOR PRE-APPEAL BRIEF CONFERENCE

In response to the Final Office Action mailed September 7, 2006, and in conjunction with the concurrently filed Notice of Appeal, Applicants request a pre-Appeal conference in view of the following remarks.

02528 (BLL-0198)

In response to the final Office Action dated September 7, 2006, Applicants respectfully request reconsideration based on the following remarks. Reconsideration and allowance of the claims are respectfully requested in view of the following remarks.

Claims 1, 3, 6, and 7 were rejected under 35 U.S.C. § 103 as being unpatentable over Yokota. This rejection is traversed for at least the following reasons.

Claim 1 recites, *inter alia*, "storing identification information associated with a delivery location, the identification information including a street address and a telephone number for the delivery location . . . causing the viewing apparatus to display the identification information on the view of the surroundings, the identification information including street address and telephone number for the delivery location to confirm that the image of the target is the delivery location."

Yokota teaches using positional information and image information to provide additional information about an object in an image, but does not teach confirming a delivery location by transmitting a street address and telephone number to the user. Yokota gives examples of information that may be obtained for objects in a view (e.g., Figure 8) but does not relate the image information to a delivery location as recited in claim 1.

In applying Yokota, the Examiner states that Yokota does not specifically disclose that the location is a delivery location and that identification information includes a street address and a telephone number for the delivery location. The Examiner continues "[o]ne of ordinary skill in the art would have recognized that any type of information could have been stored on the server for retrieval by the user to confirm thoughts about a particular location. This is viewed as a matter of design choice." (emphasis added). Applicants submit that the Examiner applied an improper standard for finding obviousness.

The rationale that other types of information "could" be used is a clearly an application of the "obvious to try" doctrine that has been admonished by the courts. The proper standard is what "would" one of ordinary skill do, not what "could" they do. There is no suggestion in Yokota that suggests one of ordinary skill in the art would implement the claimed invention.

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Further, the Examiner relies on the doctrine of "design choice" to find obviousness. This type of "design choice" analysis has been criticized by the Federal Circuit. See *In re Chu*, 36 USPQ2d 1089, citing *In re Gal*, 25 USPQ2d 1076, (the finding of obvious design choice was precluded where the claimed structure and the function it performs are different from the prior art). In the present case, using identification information that includes street address and telephone number to confirm that the image of the target is the delivery location provides a function not available in Yokota, namely the ability to coordinate the image, the telephone number and the location to effectuate a delivery. Thus, reliance on design choice is not appropriate in this case.

For at least the above reasons, claim 1 is patentable over Yokota. Claim 3 depends from claim 1 and is patentable over Yokota for at least the reasons advanced with reference to claim 1. Independent claim 6 recites features similar to those discussed above with reference to claim 1 and is patentable over Yokota for at least the reasons advanced with reference to claim 1. Claim 7 depends from claim 6 and is patentable over Yokota for at least the reasons advanced with reference to claim 6.

Claims 2, 4, 5 and 8-11 were rejected under 35 U.S.C. § 103 as being unpatentable over Yokota in view of Bide. This rejection is traversed for at least the following reasons.

With respect to claims 2, 10 and 11, Bide was relied upon for disclosing using orientation information from the viewing apparatus. With respect to claims 4, 5, 8 and 9 Bide was relied upon for disclosing providing a user with an address or a telephone number. Bide, however, fails to cure the deficiencies of Yokota discussed above with reference to claims 1 and 6. Claims 2, 4 and 5 depend from claim 1 and claims 8-11 depend from claim 6. Thus, claims 2, 4, 5 and 8-11 are patentable over Yokota in view of Bide for at least the reasons advanced with reference to claims 1 and 6.

Claims 12-17 were rejected under 35 U.S.C. § 103 as being unpatentable over Yokota in view of Bide and Hakala. This rejection is traversed for at least the following reasons.

Claim 12 as amended recites, *inter alia*, "storing identification information associated with a delivery location, the identification information including a street address and a telephone number for the delivery location . . . displaying identification information relating to the location on the view of his or her surroundings to the user, the identification information including street address and telephone number for the delivery location to

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confirm that the image of the target is the delivery location.” As discussed above, neither Yokota nor Bide teach or suggest these features. Hakala was relied upon for allegedly disclosing providing identification information as a user comes within range of a location. Hakala, however, fails to cure the deficiencies of Yokota and Bide described above. Thus, the combination of Yokota in view of Bide and Hakala fails to teach at least these features of claim 12.

For at least the above reasons, claim 12 is patentable over Yokota in view of Bide and Hakala. Claims 13-17 variously depend from claim 12 and are patentable over Yokota in view of Bide and Hakala for at least the reasons advanced with reference to claim 12.

In view of the foregoing, it is respectfully submitted that the application is in condition for allowance. Accordingly, it is respectfully requested that this application be allowed and a Notice of Allowance issued. If the Examiner believes that a telephone conference with Applicants’ attorneys would be advantageous to the disposition of this case, the Examiner is cordially requested to telephone the undersigned.

In the event the Commissioner of Patents and Trademarks deems additional fees to be due in connection with this application, Applicants’ attorney hereby authorizes that such fee be charged to Deposit Account No. 06-1130.

If any extensions of time are required under 37 C.F.R. 1.136, Applicants hereby petition for such extensions of time and authorize any extension fees to be charged to Deposit Account No. 06-1130.

If there are any charges with respect to this response or otherwise, please charge them to Deposit Account 06-1130.

Respectfully submitted,

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